

Paper No. 12  
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MARCH 23, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **The Total Quality Group, Inc.**

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Serial No. 75/078,660

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Cristina Pinheiro-Palmer of Malin, Haley, DiMaggio & Crosby  
for applicant.

David R. Nicholson, Trademark Examining Attorney, Law  
Office 103 (Michael Szoke, Managing Attorney).

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Before Quinn, Hohein and Chapman, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by The Total Quality  
Group, Inc. to register the mark STRATEGYN for "computer  
software for use in connection with developing and  
optimizing personal and business strategies and plans, not  
including statistical data analysis" (in International  
Class 9) and "business consultation, namely optimizing

business performance and product development through the process of strategic thinking" (in International Class 35).<sup>1</sup>

The Trademark Examining Attorney has refused registration under Section 2(d) of the Act in Class 9 only.<sup>2</sup> The Examining Attorney contends that applicant's mark, if applied to applicant's goods, would so resemble the previously registered mark STRATEGEN for "computer software and user manuals, sold as a unit, used to perform statistical data analysis for marketing and sales management"<sup>3</sup> as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.

Applicant argues that there is no likelihood of confusion between the marks due principally to differences between the marks and goods marketed thereunder. Applicant asserts that the term "strategy" is commonly used in the computer software industry and, thus, the cited mark is entitled to only a narrow scope of protection. Applicant

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<sup>1</sup> Application Serial No. 75/078,660, filed March 26, 1996, based on a bona fide intention to use the mark in commerce.

<sup>2</sup> The final refusal pertained to Class 9 only and, so as to be clear on this point, the Examining Attorney reiterated in his appeal brief (p. 2, n. 2) that the refusal did not apply to the services listed in Class 35. TMEP § 1113.05. Although it was an option, applicant did not file a request to divide. See: Trademark Rule 2.87; and TMEP § 1105.06.

<sup>3</sup> Registration No. 2,012,461, issued October 29, 1996.

also claims that the goods move through different channels of trade to different customers, and that applicant's customers are sophisticated. Applicant further points to the absence of any evidence of actual confusion.<sup>4</sup>

The Examining Attorney maintains that the marks are substantially similar and the software products are related.

An evidentiary matter requires our attention before we turn to the merits of the appeal. The Examining Attorney's appeal brief was accompanied by a computer-generated printout which the Examining Attorney has characterized as comprising "definitions from on-line dictionaries."

(brief, p. 5) Specifically, the Examining Attorney has requested that the Board take judicial notice of definitions of the term "business plan," further indicating as follows: "Paper copies of the respective dictionaries apparently do not exist. Electronic viewing, and screen prints of said electronic records, are the 'best evidence' of said dictionary definitions. Please note the URL addresses on the screenprints, indicating the location of said dictionaries on the [I]nternet." (brief, p. 5, n. 4)

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<sup>4</sup> The involved application is based on an intention to use the mark, although applicant's attorney has claimed that applicant first used its mark in June 1994. No documentary support for this use has been submitted.

Applicant, in its reply brief, has objected to the introduction of this evidence as untimely, and as improper factual matter for judicial notice. In making this latter objection, applicant contends that the evidence is "from a dictionary found on the [I]nternet whose source is not known." Further, applicant, in arguing that the material is not proper subject matter for judicial notice, points to the definition of "judicial notice": "the cognizance of certain facts which jurors and judges may properly take and act upon without proof, because they already know them." Black's Law Dictionary (1990). Applicant goes on to request that, in the event the Board considers the Examining Attorney's submission, the Board "also consider the evidence which the Applicant will introduce herein concerning the applicability of the Applicant's goods as compared to the applicability of the Registrant's goods." (reply brief, p. 2) Exhibits A and B, which are excerpts retrieved from the Internet, are attached to the reply brief.

Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of an appeal, and the Board will ordinarily not consider additional evidence filed by applicant or the Examining

Attorney after the appeal is filed. See also: TBMP § 1207.

Insofar as the Examining Attorney's late submission of the on-line dictionary evidence is concerned, we recognize that the Board has, in the past, taken judicial notice of dictionary listings when submitted after the appeal. Such evidence is proper subject matter for judicial notice. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), *aff'g*, 213 USPQ 594 (TTAB 1982). However, in the present case, the definitions have been retrieved from on-line dictionaries which, according to the Examining Attorney, are not available in a printed format. Under this circumstance, the Board is reluctant to take judicial notice of such matter after an ex parte appeal has been filed. The Board simply is unsure whether this material is readily available and, more significantly, the Board wonders about the reliability of it, noting applicant's legitimate concern that the dictionary's source is unknown. The evidence furnished by the Examining Attorney should have been made of record prior to the filing of the appeal, in which case applicant would have had the opportunity to check the reliability of the evidence and/or timely offer rebuttal evidence. In that situation, the Board more

readily could have assessed the reliability and probative value of the evidence. In future cases, when Examining Attorneys intend to rely on Internet evidence that otherwise would normally be subject to judicial notice (such as dictionary definitions), such evidence must be submitted prior to appeal. Cf.: *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998) [printouts of articles downloaded from the Internet, which have been introduced by means of a declaration of the person who downloaded the information, constitute admissible evidence in connection with a motion for summary judgment]. Having said all of the above, the Board is able nonetheless to take judicial notice in this case of the meaning of the term "business plan" which appears in a readily available dictionary. See infra.

The evidence filed by applicant with its appeal brief clearly is untimely under Trademark Rule 2.142(d). In view thereof, and since, in any event, the evidence was offered as an alternative if the Examining Attorney's evidence were allowed into the record (which it is not), the Board will not consider it.<sup>5</sup>

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<sup>5</sup> We hasten to add that, even if the excluded evidence were considered, we would reach the same result on the merits of this case.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services.

We first turn to compare the marks. Applicant's mark STRATEGYN and registrant's mark STRATEGEN are phonetic equivalents and differ by only one letter. Applicant posits that the one-letter difference between the marks "is enough to establish a different commercial impression," yet applicant failed to suggest what those different commercial impressions would be. Contrary to applicant's assertion, we find that the marks engender virtually identical commercial impressions, both suggesting the idea of a strategy.

We now direct our attention to a consideration of the goods, that is, applicant's "computer software for use in connection with developing personal and business strategies and plans, not including statistical data analysis" on the one hand, and registrant's "computer software and user manuals, sold as a unit, used to perform statistical data

analysis for marketing and sales management" on the other hand. It is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the goods, their channels of trade and/or classes of purchasers. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and In re Elbaum, 211 USPQ 639 (TTAB 1981).

Also, with respect to the goods, it is well settled that they need not be identical or even competitive in nature to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). We readily acknowledge that there is no *per se* rule relating to



likelihood of confusion in the computer field. In re Quadram Corp., 228 USPQ 863, 865 (TTAB 1985).

We find that applicant's and registrant's software products are sufficiently related that, when sold under virtually identical marks, confusion is likely to occur among purchasers. The term "business plan" is defined, in pertinent part, in *A Concise Dictionary of Business* (Oxford University Press 1990) as follows:

A detailed plan setting out the objectives of a business over a stated period, often three, five, or ten years. A business plan is drawn up by many businesses, especially if the business has passed through a bad period or if it has had a major change of policy. For new businesses it is an essential document for raising capital or loans. The plan should quantify as many of the objectives as possible, providing monthly cash flows and production figures for at least the first two years, with diminishing detail in subsequent years; it must also outline its strategy and the tactics it intends to use in achieving its objectives. Anticipated profit and loss accounts should form part of the business plan on a quarterly basis for at least two years, and an annual basis thereafter.

Although there obviously are specific differences between the respective software products, there is an overlap in certain respects. Applicant's software is used in developing business plans and strategies, but applicant

has excluded "statistical data analysis" from its identification of goods. It is clear, however, as shown by the dictionary definition of "business plan," that such plans and strategies necessarily include financial components (some of which, perhaps, may not involve statistical data analysis). Registrant's software, in performing statistical data analysis for marketing and sales management, likewise could be used in addressing financial issues of businesses, albeit in a different manner from applicant's software. The overlap between the products is that both may be used to study various financial aspects of a business. Although applicant takes issue with the Examining Attorney's characterization of applicant's goods, to the contrary, we think that the Examining Attorney has given a fair reading to the identification of goods which, as noted above, must control in these types of cases.

Applicant's contention that the goods move in different channels of trade to different customers is not persuasive. In the absence of any convincing evidence to the contrary, we think it reasonable to assume that the goods would move in similar channels of trade for software directed to business operations, and that customers for

applicant's business strategies and planning software would also be customers for statistical data analysis software.

We recognize applicant's attorney's point that its software is expensive and that purchasers of it are likely to be sophisticated. Suffice it to say that no evidence in support of these assertions was submitted. In any event, even careful purchasers are not immune from source confusion. We find this to be especially the case here where the marks are substantially identical and the goods are related. See: In re Linkvest, S.A., 24 USPQ2d 1716 (TTAB 1992); In re TIE/Communications Inc., 5 USPQ2d 1457 (TTAB 1987); and In re Graphics Technology Corp., 222 USPQ 179 (TTAB 1984).

The listing of the third-party registrations by applicant does not compel a different result in the present case.<sup>6</sup> The registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, and the existence on the register of confusingly similar marks cannot aid an applicant in its effort to

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<sup>6</sup> The mere listing of third-party registrations normally is insufficient to make them of record. In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974). In the present case, however, the Examining Attorney did not raise any such objection, but rather considered the registrations as if they were properly made of record. Thus, we have considered the listed registrations in making our determination.

register another mark which so resembles a registered mark as to be likely to cause confusion. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); and Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406 (CCPA 1967). Further, all of the listed marks are different from the ones involved herein.

We note applicant's attorney's claim that applicant is unaware of any instances of actual confusion. However, we cannot overlook the fact that the involved application is based on an intention to use the mark and that, at most, the mark has been in use for only a very short period of time. Thus, the lack of actual confusion might be easily explained by the fact that there has been no meaningful opportunity for actual confusion to occur in the marketplace.

To the extent that the points raised by applicant may cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register in International Class 9 is affirmed. The application file will be

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forwarded to the Examining Attorney for appropriate action  
with respect to International Class 35.

T. J. Quinn

G. D. Hohein

B. A. Chapman  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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